

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed January 3, 2006 ("Office Action"). At the time of the Office Action, Claims 1-11 were pending in the application. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Office Action rejects Claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,094,145 issued to Vilain et al. ("*Vilain*") and U.S. Patent No. 6,108,309 issued to Cohoe et al. ("*Cohoe*"). For the following reasons, Applicants respectfully submit that Claims 1-11 are patentable over the *Vilain-Cohoe* combination.

A. The Claims are Allowable over the Cited References:

In the previous Response to Office Action mailed on October 4, 2005, Applicants argued that the proposed *Vilain-Cohoe* combination does not disclose, teach, or suggest does not disclose, teach, or suggest "one or more background processes . . . which monitor communications over said control channel and which parse all communications which imply network element status changes and . . . which dynamically update said database accordingly, in real time," as recited in Applicants' Claim 1.¹ In the Final Office Action, the Examiner continues to acknowledge the failure of *Vilain* to disclose such features and relies instead upon *Cohoe* for disclosure of Applicants' "one or more background processes." (Office Action, pages 2-3).

¹ In the previous Response to Office Action submitted on October 4, 2005, Applicants also argued that the proposed *Vilain-Cohoe* combination failed to disclose: (1) one or more operator-drive processes which monitor and manage network elements in real time and (2) a database which reports attributes of ones of said network elements in response to queries from ones of said operator-driven processes. Applicants continue to believe that the arguments made with respect to these claim limitations have merit. However, for purposes of brevity and without conceding that these limitations are met by the proposed *Vilain-Cohoe* combination, Applicants have elected to focus the arguments in this Response upon the claim language reciting "one or more background processes . . . which monitor communications over said control channel and which parse all communications which imply network element status changes and . . . which dynamically update said database accordingly, in real time."

In the Final Office Action, the Examiner continues to rely upon the portion of *Cohoe* that discusses the three segments of the shared memory 140. (Office Action, page 6). Specifically, the shared memory “is organized in three main segments: a client connection segment that maintains client connection data including statuses and associated file descriptors; a mediation device management that contains the device type, the number of network elements under its span of control, and the TCP/IP port information; and a network element segment that contains detailed information about the state/status of each network element and its low level components and storage of alarms that network elements generate during the simulation execution.” (Column 9, lines 10-21). Thus, portion of the reference relied upon by the Examiner merely details the types of information stored in the three distinct segments of the shared memory. Although a “network element segment 149” of the memory 140 includes “detailed information about the state/status of each network element” (Column 9, lines 17-21), there is no disclosure in *Cohoe* that the core processes “monitor communications,” “parse all communications which imply network element status changes,” and “dynamically update” memory 140 “in real time,” as recited in Claim 1.

Rather, with regard to state requests, *Cohoe* discloses that “network elements also receive commands from the [Network Management System (NMS)] including: audit requests, provisioning requests, state requests, and switching commands.” (Column 4, lines 17-19). The network elements then “formulate response messages and send them to the NMS formatted in accordance with TL-1.” (Column 4, lines 19-22). Thus, state requests generated by the NMS are transmitted to the network elements and the network elements respond with their respective states in an ask-and-answer format. Accordingly, because *Cohoe* is limited to an ask-and-answer format for obtaining information from network elements, the simulator system of *Cohoe* cannot be said to include “one or more background processes . . . **which monitor communications over said control channel and which parse all communications which imply network element status changes and . . . which dynamically update said database accordingly, in real time,**” as recited in Applicants’ Claim 1. As such, Applicants continue to submit that the recited features are absent from the *Vilain-Cohoe* combination.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1, together with Claim 2, which depends from independent Claim 1.

Independent Claims 3 and 7 recite certain features and operations that are analogous to the features of Claim 1. For example, Claim 3 recites “monitoring communications between a network element manager and a plurality of network elements,” “parsing messages received from one or more of the plurality of network elements, which include updated configuration status information,” and “dynamically updating portions of the configuration status information.” As another example, Claim 7 recites a processor being “operable to parse messages received from one or more of the plurality of network elements, which includes updated configuration status information” and “dynamically update portions of the configuration status information with portions of the updated status information.” As described above with regard to Claim 1, the cited references do not disclose the recited features and operations. Accordingly, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that the proposed *Vilain-Cohoe* combination does not disclose, teach, or suggest each and every element recited in Applicants’ Claims 3 and 7.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 3 and 7, together with Claims 4-6 and 8-11, which depend from independent Claims 3 and 7, respectively.

B. The Proposed *Vilain-Cohoe* Combination is Improper

Furthermore, Applicants respectfully submit that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention to modify or combine *Vilain* with *Cohoe* in the manner the Examiner proposes. Applicants’ claims are allowable for at least this additional reason.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Vilain-Cohoe* combinations do not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

The governing Federal Circuit case law makes this strict legal standard clear.² According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* ***Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed***

² Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “*The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is ***rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references***. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. The Analysis

According to the Examiner, “[i]t would have been obvious” to one having ordinary skill in the art at the time of the invention “to have incorporated each of the core processes share and update common data through the use of shared memory that is organized in three man segments” as disclosed in *Cohoe* with the method of *Vilain*. (Final Office Action, page 3). The purported motivation provided by the Examiner is “to achieve a consistent and accurate view of the network element in both a cache of information immediately available to clients and a database.” (Office Action, page 3).

It appears that the Examiner has merely proposed alleged advantages of combining *Vilain* with *Cohoe* (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of the cited references, however, that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the core processes disclosed in *Cohoe* into the network management functionality disclosed in *Vilain*. In other words, the alleged advantages of the system disclosed in *Cohoe* do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (***without using Applicants' claims as a guide***) to modify the particular techniques disclosed in *Vilain* with the cited disclosure in *Cohoe*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and

conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law. Applicants respectfully submit that the Examiner's attempt to modify or combine *Vilain* with *Cohoe* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Vilain* with *Cohoe* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1-11.

CONCLUSION

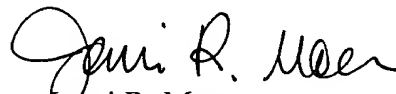
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe that no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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